UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,990	02/25/2004	Hirochika Sato	03500.100131.	8949

5514 7590 04/07/2009

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
SAFAIPOUR, HOUSHANG	

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
04/07/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/784,990	SATO, HIROCHIKA	
	Examiner	Art Unit	
	HOUSHANG SAFAIPOUR	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *38-55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *38-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The original claims 1-27 presented on 2/25/2004 were rejected in a non-final office action dated 3/21/2008. In response to the office action dated 7/9/2008, applicant canceled claims 1-27 and added claims 28-37. Applicant, on 10/23/2008, was notified that the newly submitted claims 28-37 were directed to an invention that was independent or distinct from the invention originally claimed. In response to this notification applicant has cancelled claims 28-37 and has introduced originally filed "claims 1 to 5, 8 to 10, 12 to 20 and 25 as new claims 38 to 55, albeit with additional features added." (page 12, third paragraph of Applicant's "Remarks" dated 12/23/2008). Applicant's argument with respect to the newly added independent claim 38 (pages 12-14) is moot in view of new grounds of rejection necessitated by the amendment.

Applicant further argues:

"Claims 41 and 43 are directed to a method and a computer-readable medium, respectively, substantially in accordance with the image input apparatus of Claim 38. Claim 39 is directed to an image output apparatus for use with the image input apparatus of Claim 38. Claims 42 and 44 are directed to a method and a computer-readable medium, respectively, substantially in accordance with the image output apparatus of Claim 39. Claims 40, 45 and 46 are directed to systems that utilize the image input apparatus of Claim 38. Claim 55 is directed to a computer-readable storage medium substantially in accordance with the system of Claim 45." Therefore, examiner submits that with the rejection of claim 38, claims 39 to 46 and 55 are also rejected.

Applicant has not provided any arguments with regards to other pending claims (claims 47-54) other than their dependency from the independent claims discussed above. These claims (47-54) are the same as originally filed claims (13-20). Claims 13-20 were rejected, on their own merits, in the non-final office action sated 3/21/2008. Therefore, since no argument was presented, the rejection of claims 13-20 has been applied to claims 47-54 (please see the rejection under 35 USC 103 below).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 38-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Ueda Kazuhiro (JP 2002-112009 [translation of which, used for this office action, is available on JP website]).

Regarding claims 38 , 40, 41 and 43 Ueda discloses an image input apparatus (drawing 1) which can perform data communication with an image output apparatus (drawing 2), comprising:

designation means for designating an image editing process to an original [0020];

reading means for reading image data from the original [0021];

storage means for storing the image data of the original read by said reading means [0021];

original direction detection means for detecting a direction of the original in regard to the image data [0020, rotation processing part 130];

first transmission means for transmitting a detection result by said original direction detection means and the image editing process designation by said designation means to said image output apparatus (drawings 1 & 2, abstract and [0019-0023]); and

second transmission means for reading the image data stored in said storage means and transmitting the read image data to said image output apparatus (drawings 1 and 2, [0018]).

Note: Please refer to paragraphs [005-009] for the invention objectives and for operational detail of the image processing device, please refer to pages 4-11.

Regarding claims 39, 42 and 44, Ueda discloses an image output apparatus which can perform data communication with an image input apparatus, comprising:

image processing means for performing an image process according to image editing process designation received from said image input apparatus, to image data received from said image input apparatus, on the basis of an original direction detection result received from said image input apparatus [0033-0034]; and

output means for performing print output of the image data subjected to the image process by said image processing means [0018 and 0026-0027].

Regarding claims 45, 46 and 55, Ueda discloses an image processing system which includes a first device at least having an input unit capable of inputting image data and a communication unit capable of performing data communication, and a second device at least having a communication unit capable of performing the data communication and an output unit capable of outputting image data, said system (drawings 1 and 2 [0011-0017]) comprising:

a remote output mode setting unit adapted to set a remote output mode for performing through said communication unit the data communication of the image data input by said first device and thus causing said second device to output the communicated image data [0018];

a direction detection unit adapted to detect a direction of the image data input in the first device [0027];

a transmission control unit adapted to perform control to transmit the image data to be output by said second device in the remote output mode from said first device to said second device and transmit the direction of the image data detected by said direction detection unit (drawings 1 and 2);

a reception control unit adapted to cause said second device to receive the image data and the direction of the image data transmitted from said first device (drawings 1 and 2);

an image processing control unit adapted to control said second device so as to perform an image process to the image data received from said first device, according to the direction of the image data received from said first device [0033-0034]; and

a controller adapted to cause said second device to output the image data subjected to the image process by said second device (abstract).

Regarding claim 47, Ueda discloses a control method according to Claim 46, wherein said control step enables to:

in a case where a first image forming mode in which an image editing process such as an image data rotation process is necessary is set in the remote output mode, execute a first sequence of causing the second device to output the image data transmitted from the first device, in the manner of outputting based on the direction of the image data acquired by the first device,

and in a case where a second image forming mode in which the image editing process such as the image data rotation process is unnecessary is set in the remote output mode, execute a second sequence of inhibiting the first sequence and causing the second device to output the image data transmitted from the first device, in a manner of outputting not based on the direction of the image data acquired by the first device (paragraphs [0005-0009 and 0039-0043]).

Regarding claim 49, Ueda discloses a control method according to Claim 46, wherein:

in the remote output mode, said control step enables to output from the second device a series of image data consisting of plural pages transmitted from the first device in an image direction based on the direction of the image data acquired by the first device, and in the remote output mode, said control step enables to selectively execute a first mode of processing the series of image data consisting of the plural pages based on the direction of the image data acquired for each page of the series of image data consisting of the plural pages, and a second mode of processing the series of image data consisting of the plural pages based on the direction of the image data of a predetermined page of the series of image data consisting of the plural pages (drawing 1 shows the copying machine 1 with the automatic manuscript conveying machine 10 which is indicative of handling plurality of pages [0011]. Please also refer to paragraphs [0005-0009].

Regarding claim 50, Ueda A control method according to Claim 46, wherein, in the remote output mode, said control step enables to selectively execute a first processing mode of causing the first device to generate the processed image data obtained by performing an image process based on the direction of the image data acquired by the first device to the image data input by the first device and further causing the second device to output the processed image

data, and a second processing mode of causing the second device to generate the processed image data obtained by performing the image process based on the direction of the image data acquired by the first device to the image data input by the first device and further causing the second device to output the processed image data (paragraphs [0005-0009 and 0039-0043]).

Regarding claim 51, Ueda discloses a control method according to Claim 46, wherein, in the remote output mode, in a case where a series of image data consisting of plural pages transmitted from the first device is output by the second device in a manner of outputting based on the direction of the image data acquired by the first device, said control step enables to selectively execute a first transfer mode of transferring the image data in units of page from the first device to the second device, and a second transfer mode of storing all the pages of the series of image data in the first device and then transferring in a lump the image data of all the pages from the first device to the second device [0005-0009 and 0026-0028].

Regarding claim 52, Ueda discloses a control method according to Claim 46, wherein each of the first

device and the second device includes an image input unit, an original direction detection unit, a storage unit capable of storing the image data of plural pages, and a printer unit (drawings 1 and 2 and paragraphs [0018 and 0026]).

Regarding claim 53, Ueda discloses a control method according to Claim 46, wherein at least either one of the first device and the second device is a multifunctional apparatus which has plural functions including at least any one of a copy function, a printer function, a facsimile function, a box function and a network scanner function (drawings 1 and 2).

Regarding claim 54, Ueda discloses a control method according to Claim 46, wherein at least either one of the first device and the second device is a mono functional apparatus which at least has one of a copy function, a printer function, a facsimile function, a box function and a network scanner function (drawing 1).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 47-54 (originally claims 13-20 respectively) are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda Kazuhiro (JP 2002-112009 [translation of which, used for this office action, is available on JP website]) and further in view of BIGI (US 2002/0085223).

Regarding claims 47 and 48 (originally claims 13 and 14 respectively), please refer to the arguments presented under claims 38 and 39 (originally claims 1 and 2 respectively) and also note that Bigi determines "...whether to rotate the image before printing" ([0069]) or "...how much rotation (if any) the controller should apply to the image before printing" [0027].

Regarding claims 49 and 51 (originally claims 15 and 17 respectively), combination of Ueda and Bigi discloses determining stapling position for multiple pages (BIGI, paragraphs [0052-0056 and [0064]).

Regarding claims 50 and 52 (originally claims 16 and 18 respectively), please refer to the arguments presented under claims 38 and 39.

Regarding claim 53 (originally claim 19), using multi functions (plural functions) machines is well known in the art.

Regarding claim 54 (originally claim 20), Bigi discloses a mono-functional apparatus.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HOUSHANG SAFAIPOUR whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Fri. from 6:00am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Houshang Safaipour/
Primary Examiner, Art Unit 2625